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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,211	12/31/2003	Paul A. Puniello	20002.0383	6709
23517 7590 09/24/2007 BINGHAM MCCUTCHEN LLP 2020 K Street, N.W. Intellectual Property Department WASHINGTON, DC 20006			EXAMINER LEE, EDMUND H	
			ART UNIT 1732	PAPER NUMBER
			MAIL DATE 09/24/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/748,211

Applicant(s)

PUNIELLO ET AL.

Examiner

EDMUND H. LEE

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/3/07 has been entered.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lammi (USPN 5783293) in view of Maruko et al (USPN 5823890). In regard to claim 1, Lammi teaches the basic claimed process including a method of forming a golf ball (col 5, lns 1-39; figs 1-8); forming a core (col 5, lns 1-39; figs 1-8); forming a multi-layer over the core (col 5, lns 1-39; figs 1-8); selecting a material (col 5, lns 1-39; figs 1-8); providing a first portion of the material (col 5, lns 1-39; figs 1-8); providing a second portion of the material (col 5, lns 1-39; figs 1-8); and injecting the first and second materials to form the multi-layers (col 5, lns 1-39; figs 1-8). Lammi, however, does not teach a multi-color layer; providing a first portion of the material with a first pigment

Art Unit: 1732

additive; and providing a second portion of the material with a second pigment additive, the second pigment being a different color than the first pigment additive. Maruko et al teaches a golf ball (col 1, Ins 38-42); and a multi-color cover layer, wherein the layers have different colors. Maruko et al also inherently teaches that color additives were used. Lammi and Maruko et al are combinable because they are analogous with respect to golf balls. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to color the cover layers of Lammi as taught by Maruko et al in order to form a good appearing golf ball. In regard to claims 2-5,7-9,12 and 14, such are taught by Lammi (col 5, Ins 1-39; figs 1-8). In regard to claims 6,10 and 11, Lammi does not teach forming an outer cover layer and an inner cover layer of substantially the same thickness; forming a substantially white first portion; and forming a substantially translucent cover over the multi-color layer. In regard to forming an outer cover layer and an inner cover layer of substantially the same thickness, such is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, golf balls having an outer cover layer and an inner cover layer of substantially the same thickness are well-known in the golf ball art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the inner and outer cover layers of Lammi with substantially the same thickness in order to form a golf ball having a specific playing characteristic. In regard to forming a substantially white first portion, such is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the

Art Unit: 1732

claimed process since it is not a manipulative feature or step of the claimed process.

Further, golf balls having a substantially white cover layer are well-known in the golf ball art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to color the first portion of Lammi white in order form a good appearing golf ball. In regard to forming a substantially translucent cover over the multi-color layer, such is well-known in the golf ball art in order to form a good appearing golf ball. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form a substantially translucent cover over the multi-color layer of Lammi (modified) in order to form a good appearing golf ball.

4. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lammi (USPN 5783293) in view of Maruko et al (USPN 5823890). In regard to claim 15, Lammi teaches the basic claimed process including a method of forming a golf ball (col 5, lns 1-39; figs 1-8); forming a core (col 5, lns 1-39; figs 1-8); forming a cover layer of multiple layers over the core (col 5, lns 1-39; figs 1-8); selecting a material (col 5, lns 1-39; figs 1-8); providing a first portion of the material (col 5, lns 1-39; figs 1-8); providing a second portion of the material (col 5, lns 1-39; figs 1-8); and injecting the first and second materials to form the cover layers (col 5, lns 1-39; figs 1-8). Lammi, however, does not teach a multi-color layer; providing a first portion of the material with a first pigment additive; and providing a second portion of the material with a second pigment additive, the second pigment being a different color than the first pigment additive. Maruko et al teaches a golf ball (col 1, lns 38-42); and a multi-color cover

Art Unit: 1732

layer, wherein the layers have different colors and the different colors are visible on the cover layer (col 1, lns 38-42). Maruko et al also inherently teaches that color additives were used. Lammi and Maruko et al are combinable because they are analogous with respect to golf balls. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to color the cover layers of Lammi as taught by Maruko et al in order to form a good appearing golf ball. In regard to claim 16, such is taught by the above combination of Lammi and Maruko et al. In regard to claim 17, such is well-known in the golf ball art in order to form a good appearing golf ball. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form a substantially translucent cover over the multi-color cover layer of Lammi (modified) in order to form a good appearing golf ball.

5. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lammi (USPN 5783293) in view of Maruko et al (USPN 5823890) and Meyer (USPN 4998734). Lammi teaches the basic claimed process including a method of forming a golf ball (col 5, lns 1-39; figs 1-8); forming a core (col 5, lns 1-39; figs 1-8); forming a cover layer of multiple layers over the core (col 5, lns 1-39; figs 1-8); selecting a material (col 5, lns 1-39; figs 1-8); providing a first portion of the material (col 5, lns 1-39; figs 1-8); providing a second portion of the material (col 5, lns 1-39; figs 1-8); and injecting the first and second materials to form the cover layer (col 5, lns 1-39; figs 1-8). Lammi, however, does not teach a multi-color layer; providing a first portion of the material with a first pigment additive; providing a second portion of the material with a second pigment

Art Unit: 1732

additive, the second pigment being a different color than the first pigment additive; and forming a substantially translucent cover over the multi-color cover layer. Maruko et al teaches a golf ball (col 1, Ins 38-42); and a multi-color cover layer, wherein the layers have different colors. Maruko et al also inherently teaches that color additives were used. Lammi and Maruko et al are combinable because they are analogous with respect to golf balls. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to color the cover layers of Lammi as taught by Maruko et al in order to form a good appearing golf ball. In regard to forming a substantially translucent cover over the multi-color cover layer, Meyer teaches a golf ball having a translucent layer over a cover layer in order to form a shiny appearance (col 2, Ins 45-61). Lammi and Meyer are combinable because they are analogous with respect to golf balls.. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form a substantially translucent layer over the cover layer of Lammi (modified) as taught by Meyer in order to form a good appearing golf ball, i.e., one that has a shiny appearance.

6. Applicant's arguments filed 7/3/07 have been fully considered but they are not persuasive. Applicants main argument is the modifying of Lammi with Maruko would produce a golf ball having a poor outer appearance. This argument is misplaced because Maruko strives to produce a golf ball layer of two layer structure consisting of inner and outer layers, wherein a color difference between the layers is controlled such that an improved outer appearance is achieved, i.e., the parting line is free from

Art Unit: 1732

appearance defects including tracks of seams and streaks perceivable to the naked eyes. See Maruko at col 2, Ins 2-24. Since Maruko teaches a golf ball having an improved appearance, the combination of Lammi and Maurko as set forth in the above rejections would produce a golf ball having an improved outer appearance.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is 571.272.1204. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571.272.1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 1732

EDMUND H. LEE
Primary Examiner
Art Unit 1732

EHL

Edmund H. Lee
9/17/04